REMARKS/ARGUMENTS

Claims 13 and 17 are amended to correct antecedent basis and claim 29 is new. Following entry of the present amendment, claims 1-29 will be pending. Support for the new claim is found in the summary of the invention. Applicants believe no new matter is present in any portion of the preliminary amendment and respectfully request that the amendment be entered for substantive examination.

The Patent Office has requested restriction to one of the following inventions (Groups I-V):

I. Claims 1-21 and 28, drawn to a method for preparing a library of compounds using various synthesis templates, classified variously, for example in class 435, subclass DIG 49.

II. Claim 22, drawn to a library of compounds comprising compounds and their synthesis templates, classified variously, for example in class 435, subclass DIG 34.

III. Claim 23, drawn t a library of compounds comprising cleaved compounds, classified variously, for example in class 536, subclass 26.12.

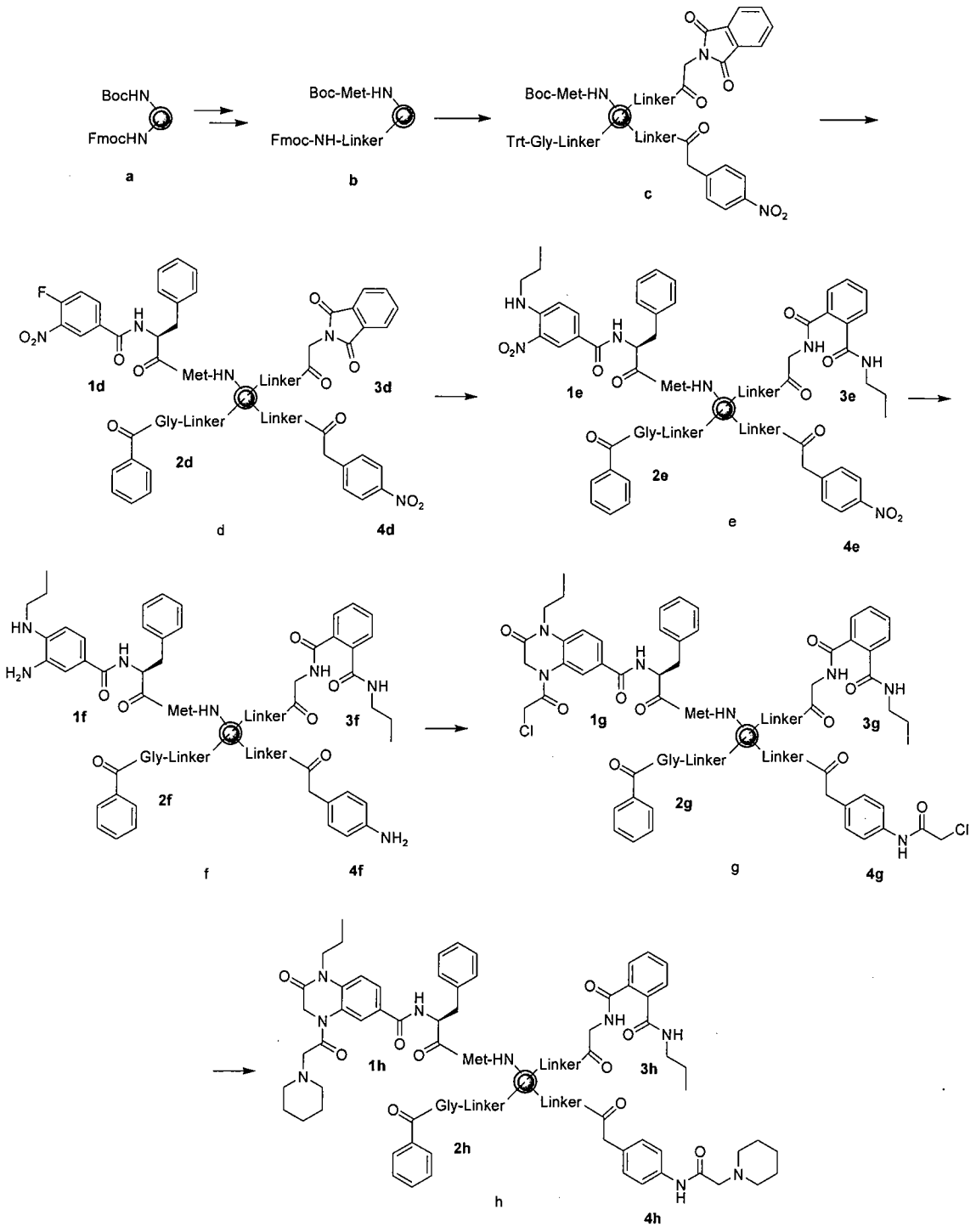
IV. Claims 24 and 25, drawn to a method of identifying a compound attached to its synthesis template that binds to a target, classified variously, for example in class 435, subclass DIG 14.

V. Claims 26 and 27, drawn to a method of identifying a compound cleaved from its synthesis template that binds to a target, classified variously, for example in class 544, subclass 283.

Applicants elect to prosecute the invention of Group I (claims 1-21 and 28, drawn to method for preparing a library of compounds using various synthesis templates). The Patent Office has also requested Applicants to elect a single disclosed species wherein a representative

element of the following nine elements are specified. In response, Applicants elect the method of Example 6 comprising

1) a synthesis template which comprises: a **TentaGel resin bead** solid support, wherein said solid support has an interior portion with a plurality of **of Fmoc-linker** reactive functional groups; an exterior portion **of Boc** reactive functional groups; and **two** coding tag precursors *N*-**phthaloylglycine and 4-nitrophenylacetic acid**. The synthesis template would have the structure **c** in the following scheme.



IUPAC does not have a name for such a structure of the synthesis template.

2) Contacting a first synthesis template with a first reactive component **propylamine** such that a first scaffold functional group reacts with said first reactive component **propylamine** to afford a first scaffold building block, **1e**, and a first coding functional group reacts with said first reactive component **propylamine** to afford a first coding building block, **3e**;

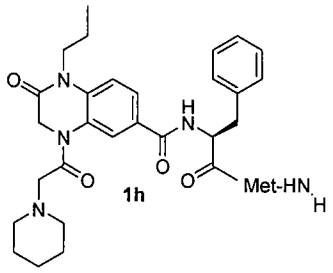
3) contacting said first synthesis template with a successive reactive component $SnCl_2$ such that a subsequent scaffold functional group reacts with said successive reactive component to afford a subsequent scaffold building block **1f**, and a subsequent coding functional group reacts with said successive reactive component $SnCl_2$ to afford a subsequent coding building block, **3f;**

4) repeating step c) until said first compound **1g** has been prepared; and

5 and 6) subjecting additional synthesis templates to steps b) - d) with additional reactive components **piperidine** to prepare a compound, **1h**;

7) wherein said reactive component reacts with said scaffold functional group and said coding functional group via a reaction selected from the group consisting of amine acylation, reductive alkylation, aromatic reduction, aromatic acylation, aromatic cyclization, aryl-aryl coupling, [3+2] cycloaddition, Mitsunobu reaction, nucleophilic aromatic substitution, sulfonylation, aromatic halide displacement, Michael addition, Wittig reaction, Knoevenagel condensation, reductive amination, Heck reaction, Stille reaction, Suzuki reaction, Aldol condensation, Claisen condensation, amino acid coupling, amide bond formation, acetal formation, Diels-Alder reaction, [2+2] cycloaddition, enamine formation, esterification, Friedel Crafts reaction, glycosylation, Grignard reaction, Horner-Emmons reaction, hydrolysis, imine formation, metathesis reaction, **nucleophilic substitution**, oxidation, Pictet-Spengler reaction, Sonogashira reaction, thiazolidine formation, thiourea formation and urea formation;

8) cleaving said compound having the chemical structure



1h

from said synthesis template;

9) that binds to a target **streptavidin, protein kinase, etc**.

Claims 1-6, 8-18, 20 and 29 are readable thereon.

Moreover, Applicants election is made with traverse. The Office alleges that Groups I, II and II represent distinct inventions, though related as product and process of making the product. The Patent Office alleges that the inventions are distinct as the product can be made by a materially different process (MPEP §806.05(f)). The Patent Office characterizes the products of Group 2 and 3 as biological macromolecules that might be isolated from biological systems and attached to a solid support. The Patent Office conjecture is insufficient evidence to support such a restriction.

Further, under 35 U.S.C. § 121, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

(1) the inventions must be independent or distinct as claimed; and

(2) there must be a serious burden on the examiner if restriction is not required (emphasis added). *See* MPEP § 803. Applicants submit that both these criteria are not met by the presently claimed invention.

The claims of Groups I-V encompass a single inventive concept. Specifically, the present invention provides compositions made a specific method and methods of making and

identifying the compositions. Accordingly, Applicants believe that any search for methods of making the compositions of the invention will provide materials relating to methods using the compositions. The Patent Office even notes that all of the method claims belong to the same class. Thus, Applicants believe that prosecution of the invention, as a whole, would not place a serious burden on the Office sufficient to justify restrictions.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for substantive review on their merits. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5014.

Respectfully submitted,

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